

REMARKS

Claims 14-41 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition.

I. Rejection of Claims 14-16 and 37-41 under 35 U.S.C. § 112, First Paragraph

Claims 14-16 and 37-41 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement because the specification allegedly does not reasonably provide enablement for “the limitation of ‘terminating, by the terminal, the call without accepting the call.’” (Final Office Action, page 2). Specifically, the Final Office Action alleges that “[t]he specification fails to disclose what steps are needed to cause a mobile terminal to terminate a call prior to accepting it.” *Id.* It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation.” United States v. Teletronics, Inc., 857 F.2d 778, 785 (Fed. Cir. 1988). The critical test is not whether experimentation is necessary or complex, but whether the *experimentation is undue*. In re Angstadt, 537 F.2d 498 (C.C.P.A. 1976). It is well settled that an applicant need not make or test all embodiments of the claimed subject matter in order to meet the enablement requirement of 35 U.S.C. § 112. So long as the Specification discloses at least one manner of making and using the claimed subject matter that bears a reasonable correlation to the entire scope of the claim, the enablement requirement of 35 U.S.C. § 112 is satisfied. In re Fisher, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970). As set forth in the Substitute Specification, e.g., at page 3, lines 19-30; page 4, lines 4-14 and 25-30; page 6, lines 1-20; page 7, lines 17-19; page 8, line 29 to page 9, line 25; and in Figures 1-4, relating to claims 14-16 and 37-41, the Substitute Specification discloses methods for making the claimed subject matter that bears a sufficient correlation to the entire scope of each claim. Specifically, e.g., regarding the limitation of “terminating, by the terminal, the call without accepting the call,” the Substitute Specification provides that “[t]he server then calls the selected call number, i.e., the thus identified terminal, via the network or via a direct connection and a dial-in node via a mobile wireless network ... [t]he terminal receives the call and subjects it to a check ... [i]f it is a call via which establishment of a connection is requested, the device ... immediately terminates

the incoming call (without the connection having been established) and starts establishing the connection” (Substitute Specification, page 4, lines 9-14 and 25-30). The particular details of how a mobile terminal would terminate a call prior to accepting it would be readily understood to a person of ordinary skill in the art and need not be spelled out in the Substitute Specification.

In view of the foregoing, it is respectfully submitted that claims 14-16 and 37-41 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

II. Rejection of Claims 14-22, 26-27, 37, 39 and 41 under 35 U.S.C. § 102(b)

Claims 14-22, 26-27, 37, 39 and 41 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kennedy, III et al. (US Patent Number 5,734,981). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claims 14-16, 37, 39 and 41 recite, in relevant parts, a control center that calls a terminal; the terminal terminates the call without accepting the call; the terminal checks, on the basis of data delivered by the call, whether a connection to the control center is

permitted to be established; the terminal establishes a connection by calling the control center; and then data is transmitted via the connection. Independent claims 14-16, 37, 39 and 41 provide a specific way to establish a connection between a control center and a terminal that is cost effective and safe. When the control center calls the terminal the terminal receives data, *i.e.*, the call number, but does not establish the connection (accept the call). Not accepting the call provides a cost savings. Next, if the control center is permitted to communicate with the terminal, the terminal establishes a connection by calling the control center. Accordingly, a secure connection is established. In contrast, Kennedy III et al. do not disclose such a system; instead, Kennedy III et al. describe that platform (center) 18 sends a call back message to the mobile unit. (Column 10, lines 13-24). This message is received by the mobile unit, thereby establishing a connection with costs. Then, the mobile unit calls back automatically. Specific details of how this system works is shown in Figure 6, which shows that at step 254 the message is sent to the mobile unit. Sending such a message would require the establishment of a connection and costs are typically associated with such a connection. In one case, the center terminates the connection and the mobile unit calls back a caller, which is not the center. In the other case, the mobile unit calls the center. While Kennedy III et al. do not specify how the call is interrupted, a person skilled in the art would readily infer that the center interrupts the call. This system is not as safe as the system recited in independent claims 14-16, 37, 39 and 41 because the mobile unit (the user) can not control all the actions. Kennedy III et al. do not describe building a connection by terminating a call by a terminal (*e.g.*, a mobile unit) without a connection being established, and therefore Kennedy III et al. do not teach a system that takes into account both cost and security issues. For at least these reasons, claims 14-16, 37, 39 and 41 are allowable over Kennedy III et al.

As for 17-22 and 26-27, which ultimately depend from independent claims 14-16, and therefore include all of the features recited in independent claims 14-16, it is respectfully submitted that Kennedy III et al. do not anticipate these dependent claims for at least the same reasons more fully set forth above in support of the patentability of independent claims 14-16, 37, 39 and 41.

For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 23-25 and 28-30 under 35 U.S.C. § 103(a)

Claims 23-25 and 28-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy III et al. in view of Oka (U.S. Patent No. 6,091,945).

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. The Examiner must show, inter alia, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. §2143. To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 23-25 and 28-30 are each dependent on independent claim 14, 15 or 16, and therefore these dependent claims include, *inter alia*, the feature that the terminal terminates the call without accepting the call from the server. As noted above, Kennedy III et al. clearly fail to teach or suggest this claimed feature. Furthermore, Applicants note that Oka clearly does not teach or suggest this claimed feature. Therefore, claims 23-25 and 28-30 are not rendered obvious by the combination of Kennedy III et al. and Oka because these references fail to teach or suggest the feature that the terminal terminates the call without accepting the call from the server.

For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 31, 33-36, 38 and 40 under 35 U.S.C. § 103(a)

Claims 31, 33-36, 38 and 40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy III et al. in view of Kolls (U.S. Patent No. 6,856,820 B1).

Claims 31 and 33-36 each ultimately dependent on independent claim 14, 15 or 16, and therefore these dependent claims include, *inter alia*, the feature that the terminal terminates the call without accepting the call from the server. Independent claims 38 and 40 also include this feature. As noted above, Kennedy III et al. clearly fail to teach or suggest this claimed feature. Furthermore, Applicants note that Kolls clearly fails to teach or suggest this claimed feature. Therefore, claims 31, 33-36, 38 and 40 are not rendered obvious by the combination of Kennedy III et al. and Kolls because these references fail to teach or suggest the feature that the terminal terminates the call without accepting the call from the server.

For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 32 under 35 U.S.C. § 103(a)

Claim 32 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy III et al. in view of Oka and in further view of Kolls.

Claim 32 is dependent on independent claim 15, and therefore claim 32 includes, *inter alia*, the feature that the terminal terminates the call without accepting the call from the server. As noted above, none of Kennedy III et al., Oka and Kolls teach or suggest this claimed feature. Therefore, claim 30 is not rendered obvious by the combination of Kennedy III et al., Oka and Kolls because these references fail to teach or suggest the feature that the terminal terminates the call without accepting the call from the server.


For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

CONCLUSION

In light of the foregoing, Applicants respectfully request allowance of all pending claims. Prompt reconsideration of the present application is earnestly solicited.

Respectfully Submitted,

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